REMARKS

In the Office Action, the Examiner rejected claims 1-8 and 27-37 under 35 U.S.C. § 102(b) as being anticipated by Jin Jung et al., A Proxy Assisted On-Line Predictive Prefetching Algorithm (hereinafter *Jung*). Also, claims 1-8 and 27-37 were rejected under 35 U.S.C. § 102(e) as being anticipated by Ferguson, U.S. Patent No. 6,769,019 (hereinafter *Ferguson*).

No claim amendments are made herein. Accordingly, claims 1-8 and 27-37 remain pending in the application. For the reasons set forth below, the Applicants respectfully request reconsideration and allowance of all pending claims.

CLAIM REJECTIONS - 35 U.S.C. § 102b

According to M.P.E.P. § 2131, 35 U.S.C. 102 "A person shall be entitled to a patent unless- . . . (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

35 U.S.C. 132 requires that an examiner include in the action reasons for any rejection, objection or requirement. A PTO patent application claim rejection violates Section 132 if it "is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection." Chester v. Miller, 906 F.2d 1574, 1578, 15USPQ2d 1333, 1337 (Fed. Cir. 1990). In the Office Action, the Examiner has failed to explicitly show that each and every element as set forth in each of the rejected claims is taught or suggested by the cited reference; therefore a *prima facie* case for rejection under U.S.C. 102 (b) has not been made. Hence the Applicant is unable to respond to the rejection of these claims.

In particular, the Examiner has failed to point out where any element of claims 1-8 and 27-37 are taught or suggested in *Jung*. The Examiner has merely cited the reference as anticipating the claims, without any indication as to where within those sections any element of the rejected claims was taught or suggested.

The Applicant therefore respectfully requests that the Examiner explicitly specify, for each rejected claim, where each and every element of the claim is taught or suggested by the cited reference.

CLAIM REJECTIONS - 35 U.S.C. § 102e

A claim is anticipated only if each and every element of the claim is found in a single reference. M.P.E.P § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the claim." M.P.E.P. § 2131 (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226 (Fed. Cir. 1989)).

Claims 1-8 and 27-37 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Ferguson.* Applicant respectfully asserts that the *Ferguson* reference doesn't qualify as prior art under 35 U.S.C. § 102(e). More specifically, in view of the C.F.R. § 1.131 declaration filed herewith, it is clear that subject matter corresponding to the claimed invention of the present application was invented prior to the priority date of *Ferguson*, December 10, 1997. As declared by Applicant (Michael Tso), the subject matter of the claimed invention was reduced to actual practice prior to December 10, 1997. This is further supported by each of Exhibits A and Exhibit B. As stated under the "Value of invention to Intel" section of Exhibit A, "We expect the 1.0 product to be shipped by 4/15/97, with 2 follow on products within six months." As declared by Michael Tso, the subject matter of the present invention was incorporated in the "Scappoose" proxy server, which was a code name for Intel's Quick Web Technology. As identified by the press release of September 25, 1997, market trials of the Intel Quick Web Technology were to begin in October, 1997. Clearly, the subject matter of the present invention was incorporated in an actual product (the Intel Quick Web Technology) prior to the priority date of *Ferguson*, and thus reduced to practice prior to the priority date of *Ferguson.* Accordingly, *Ferguson* does not qualify as a proper 35 U.S.C. § 102(e) reference.

In light of the declaration submitted herewith, the rejection of each of claims 1-8 and 27-37 under 35 U.S.C. § 102(e) as being anticipated by *Ferguson* is improper because the *Ferguson* reference does not qualify as prior art. As a result, the rejection should be withdrawn.

With respect to the inclusion of Jin Jing on the Invention Disclosure Form (IDF) but not being a named inventor in the present application, Jin Jing was the inventor of subject matter that was included in the IDF but not claimed in the present application (*e.g.*, aspects of the client prefetching generation and (remote) proxy request prediction). Rather, this subject matter was included and claimed in another application.

If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to the allowability of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (503) 439-8778.

Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

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